

REMARKS

I. Status of Claims

Claims 96-98, 101, 123, 135, 142, 167, 170, 175, 192, 194, and 203-206 are pending in this application.¹

II. Interview Summary

Applicants thank Examiner Venkat for the telephonic interview on June 25, 2007, with the Applicants' representative, Courtney Meeker. The pending claims and current rejection under 35 U.S.C. § 112, first paragraph, were discussed. The parties did not reach an agreement with respect to the claims.

III. Rejection Under 35 U.S.C. § 112, First Paragraph

The Office has rejected claims 96-98, 101, 123, 135, 142, 167, 170, 175, 192, 194, and 203, 205, and 206 under 35 U.S.C. § 112, first paragraph, for failing to meet the enablement requirement. See Office Action at 2-3. The Office alleges that "[t]he specification does not enable any person skilled in the art . . . to use the invention commensurate in scope with these claims." See *id.* at 3. Specifically the Office cites the examples section of the specification, noting that the table shows the method of providing intense color using one species belonging to formula I. *Id.* at 6-8. The

¹ Applicants note that the Office indicates that claim 95, rather than claim 96, is currently pending. Applicants note that claim 95 was cancelled in the December 27, 2006, Amendment and Submission Under 37 C.F.R. § 1.114; whereas, claim 96 was indicated as still pending in the same paper. Moreover, at page 4 of the Office Action, the Office copied claim 96, not claim 95. Therefore, Applicants address the rejection herein as applicable to claim 96, not claim 95, and presume the claim listing was the Office's error.

Examiner alleges that because only one species was tested, the other species are not enabled. *Id.*

Applicants respectfully disagree. The Office has the burden of establishing a reasonable basis to question the enablement provided for the claimed invention. See M.P.E.P. § 2164.04; *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (requiring that the examiner provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). “A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.” M.P.E.P. § 2164.04

In this case, the Office has failed to meet its burden. As the Office acknowledges, the specification does enable a method for providing intense color using ethylenediamine/stearyl dimer tallate copolymer, as recited in claim 204. See Office Action at 9. Contrary to the Office’s allegation, the specification further enables a method for providing intense color in a cosmetic composition, wherein the cosmetic composition comprises: (i) at least one heteropolymer comprising a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom; and (ii) at least one coloring agent, wherein said at least one heteropolymer is included in said composition in an amount effective to provide said intense color. See, e.g., claim 96. The specification provides general ranges for the

various components of the inventive compositions and other such details that enable the invention, in addition to the example contained therein. See e.g., Specification at 19, 21. Moreover, as understood by a person of ordinary skill and explained in the specification, the intensity of the color is measured by the L value, where an increase in intensity of color results in a proportional decrease in the L value. See *id.* at 19. Thus, one of ordinary skill would be enabled to practice the full scope of the claimed invention without undue experimentation.

The mere fact that the specification includes testing for one species is in and of itself irrelevant to Office's erroneous conclusion of non-enablement. Rather, the courts have held that the specification need not contain any examples if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. See *In re Borkowski*, 422 F.2d 904, 908, 164 USPQ 642, 645 (C.C.P.A. 1970). In fact, the courts have instructed that a single embodiment can provide broad enablement involving well-known factors. See, e.g., *Ex parte Hitzeman*, 9 USPQ 2d 1821, 1823 (BPAI 1988), *Spectra Physics v. Coherent, Inc.*, 3 USPQ 2d 1737, 1743 (BPAI 1987). Applicants respectfully submit that the example provided in the present specification (directed to ethylenediamine/stearyl dimer tallate copolymer) enables one of ordinary skill in the art to practice the use of other embodiments, as recited in the pending claims, without undue experimentation.

For these reasons, Applicants maintain that the pending claims are enabled, and allowable. Accordingly, Applicants respectfully request that the Office withdraw the rejection under § 112, first paragraph, and allow all pending claims.

IV. Commonly Assigned Co-Pending Applications and Patents

As in previous submissions, for the Office's convenience, Applicants have provided herewith in Exhibit 1 copies of the currently pending or allowed claims from the following co-pending applications, which claims have been amended or allowed since December 27, 2006, in the following applications: 10/993,430; and 10/466,166. Applicants submit these claims for the Office's convenience in evaluating any potential issues regarding statutory or obviousness-type double patenting.

V. Information Disclosure Statement

Applicants thank the Office for acknowledging that the references listed on the IDS Forms PTO/SB/08 submitted on December 27, 2006 have been considered. At page 2 of the Office Action, however, the Office states that "foreign patents, which are not in English and that, do not have corresponding equivalents or English equivalents have been considered to the extent that it reads only on the abstract." In this regard, Applicants note that translations of foreign documents are not required, and "[s]ubmission of an English language abstract of a reference may fulfill the requirement for a concise explanation." M.P.E.P. § 609.04(a).III. In the IDS Form PTO/SB/08 filed with the IDS on December 27, 2006, English language abstracts of the foreign documents were listed, considered, and initialed by the Examiner. See Office Action, page 2 and initialed IDS Form PTO/SB/08, attached thereto. As such, Applicants have complied with the Office's requirements for the foreign documents; if the Office does not agree, Applicants would respectfully request citation to a rule or regulation establishing otherwise.

For the Office's further consideration, Applicants submit a Supplemental Information Disclosure Statement herewith. As such, Applicants respectfully request that the Office consider the cited documents and indicate that they were so considered as the M.P.E.P. dictates.

VI. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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